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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,894	04/10/2001	Robert Barritz	P/1318-127	8555

2352 7590 11/29/2006

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EXAMINER

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ART UNIT PAPER NUMBER

3625

DATE MAILED: 11/29/2006

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/829,894
Filing Date: April 10, 2001
Appellant(s): BARRITZ, ROBERT

Mr. Max Moskowitz
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 31, 2006 appealing from the Office action mailed January 26, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The amendment after final rejection filed on 5/2/2006 has been entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

Art Unit: 3625

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,684,369

Bernardo et al

1-2004

Girishankar, Saroja "Build the e-commerce catalog" Information Week dated November 29, 1999.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In Claim 1, the word "criteria" is a relative word, which renders the claims indefinite. The word "criteria" is not defined by the claim(s), the specification does not provide a standard for ascertaining the requisite degree other than providing some examples, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention. Moreover, the word "criteria" as recited is so broad that establishing the metes and bounds of the claim are almost impossible. For examination purposes the word "criteria" will be defined as a user employing a standard on which a judgment or decision is based. For example, a shoe store owner is not going to seek out products on fire hoses too. Rather, they will base their requirements on the business needs such as shoes or related merchandise, which will be the standard upon which their decision will be made. As another example, they will not search for and download information on products, which do not related to the their business.

Claims 1 and 2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, the word(s) "semi-automatically" and "substantially automatically" are a relative word/phrase(s), which renders the claims indefinite. The word "semi-automatically" and "substantially automatically" are not defined by the claim(s), the specification does not provide a standard for ascertaining

Art Unit: 3625

the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention. For examination purposes the word "semi-automatically" and "substantially automatically" will be treated as a search criteria being entered each time for each separate item/merchandise by an individual such as business owner. Thereby, these steps are completed in a "semi-automatic" as well as "substantially automatically" fashion as result of each search criteria being entered manually and the results of the search for these products are downloaded/presented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bernardo (US 6,684,369 B1) in view of "Build the e-commerce catalog"; Saroja Girishankar; Information Week; Nov. 29, 1999 and hereafter referred to as "Catalog".

Regarding claim 1 (currently amended), Bernardo teaches a website constructor, comprising:
a website organization module that defines a look and feel of the website constructed by the website constructor (see at least Abstract);
a graphic design module that creates at least one website layout and features setup for the website constructed by the website constructor (see at least Figures 4 - 12); and
a website builder that builds the website based on the criteria and conditions that have been setup by the foregoing modules (see at least Abstract, Col 1, lines 31 – 32, Col 2, lines 49 – 60, Col 3, lines 34 – 38 and Figures 5 and 30).

While it is implicit in Bernardo that a merchant would establish a criteria for selecting merchandise such as selecting shoe related items for a shoe store and not fire hoses too, the reference does not specifically disclose or teach a selection criteria module that establishes a selection criteria for merchandise selection, a merchandise selection module in the website constructor that selects merchandise offered for sale on the website constructed by the website constructor that matches the selection criteria at least semi-automatically, the merchandise selection module being based on merchandise made available by a plurality of vendors; a merchandise information downloading module that downloads substantially automatically, from a plurality of vendors of merchandise, merchandise information defining the merchandise offered for

Art Unit: 3625

sale on the website constructor by the website constructor that has been selected by the merchandise selection module.

On the other hand, Catalog teaches a website constructor comprising a selection criteria module that establishes a selection criteria for merchandise selection (see at least Page 1 and 2),

a merchandise selection module in the website constructor that selects merchandise offered for sale on the website constructed by the website constructor that matches the selection criteria at least semi-automatically, the merchandise selection module being based on merchandise made available by a plurality of vendors (see at least Pages 1 - 3);

a merchandise information downloading module that downloads substantially automatically, from a plurality of vendors of merchandise, merchandise information defining the merchandise offered for sale on the website constructor by the website constructor that has been selected by the merchandise selection module (see at least Pages 1 - 4).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have provided the constructor of Bernardo with the constructor of Catalog to have enabled a constructor comprising a selection criteria module that establishes a selection criteria for merchandise selection, a website organization module that defines a look and feel of the website constructed by the website constructor; a graphic design module that creates at least one website layout and features setup for the website constructed by the website constructor ; a merchandise selection module in the website constructor that selects merchandise offered for sale on the website constructed by the website constructor that matches the selection criteria at least semi-automatically, the merchandise selection module being based on merchandise made available by a plurality of vendors; a merchandise information downloading module that downloads substantially automatically, from a plurality of vendors of merchandise, merchandise information defining the merchandise offered for sale on the website constructor by the website constructor that has been selected by the merchandise selection module and a website builder that builds the website based on the criteria and conditions that have been setup by the foregoing modules – in order to enable a business to establish and conduct business at virtual site on the internet. Bernardo discloses a constructor for that defines look and feel and graphic design module for website layout (Abstract). In turn, Catalog discloses a constructor with a selection criteria module that establishes a selection criteria for merchandise selection, a merchandise selection module in the website constructor that selects merchandise offered for sale on the website constructed by the website constructor that matches the selection criteria at least semi-automatically, the merchandise selection module being based on merchandise made available by a plurality of vendors; a merchandise information downloading module that downloads substantially automatically, from a plurality of vendors of merchandise, merchandise information defining the merchandise offered for sale on the website constructor by the website constructor that has been

Art Unit: 3625

selected by the merchandise selection module (see at least Pages 1 - 3). Therefore, one of ordinary skill in the art at the time of the applicant's invention would have been motivated to extend the constructor of Bernardo with a constructor comprising a selection criteria module that establishes a selection criteria for merchandise selection, a merchandise selection module in the website constructor that selects merchandise offered for sale on the website constructed by the website constructor that matches the selection criteria at least semi-automatically, the merchandise selection module being based on merchandise made available by a plurality of vendors; a merchandise information downloading module that downloads substantially automatically, from a plurality of vendors of merchandise, merchandise information defining the merchandise offered for sale on the website constructor by the website constructor that has been selected by the merchandise selection module. In this manner, the investment required by the website owner can be reduced as well the time to establish the website, which will enabled a more rapid ability to obtain sales on the web and thereby begin recouping the investment.

Regarding claims 2 and 3, Bernardo teaches wherein the system is operable semi-automatically (Figure 30) and in which the website is optimized for a retail operation (Col 1, lines 31 - 32).

Regarding claim 4, Catalog teaches the website constructor, in which merchandise information comprises at least two of the following merchandise parameters that are selected from the group consisting of: product code, UPC code, SKU code, product description, retail price, product style, product color, product size, product ordering information, product incentive program, product image, and product tags (Pages 1, 2 and 4).

Regarding claim 5, Catalog teaches a website constructor, in which the merchandise information is provided in Extensible Markup Languages (XML) [Page 3].

Regarding claim 6, Catalog teaches in which the selection criteria comprises at least two parameters selected from the parameter group consisting of: category; subcategory; manufacturer; vendor; promotions; closeout; starting date and ending date of seasonal merchandise (Page 1).

Regarding claim 7, Bernardo teaches a website constructor, in which the website organization module defines the look and feel of the website by reference to one or more organization parameters selected from the parameter group consisting of: category; manufacturer; promotions; close-out; product appearance; and tags representing the begin and end dates for the placement of merchandise on the website ((Abstract).

Regarding claim 8, Catalog teaches in which the merchandise selection module enables a user of the website constructor to control downloading of merchandise information in a

Art Unit: 3625

manner which enables: acceptance or rejection of marketing or merchandise information based on the selection criteria; selection of purchase orders, pricing schedules, and delivery schedules; and specification of loading information (Pages 1 and 4).

Regarding claim 9, Bernardo teaches a website constructor in which the website builder enables periodical rebuilding of the website (Figure 30).

Regarding claim 10, Bernardo teaches a website constructor, which a website builder enables rebuilding of the website based on the detection of changed condition (Figure 30).

Regarding claim 11, the recitation that "in which the changed condition comprises a changed date", such recitation is given little patentable weight because it imparts no structural or functional specificity which serves to patentably distinguish the instant invention from the other "condition" already disclosed by Bernardo.

Regarding claims 12 and 13, the recitations that "in which the changed condition comprises the changing of the merchandise information by a vendor" and "in which the changed condition constitutes a manual intervention by a user of the website, such recitations are given little patentable weight because it imparts no structural or functional specificity which serves to patentably distinguish the instant invention from the other "condition" already disclosed by Bernardo.

(10) Response to Argument

Claim Rejections - 35 USC § 112 Rejection

Appellant argues that the term "substantially automatic" is not indefinite. The examiner acknowledges that there is disclosure that defines the term "substantially automatic", however since one of ordinary skill in the art cannot ascertain what is automated and what is not by the disclosure, the term "substantially automatic" is still considered to be indefinite.

The applicant's arguments regarding numerous Patent claims containing the words/phrases "semi-automatically" as well as "substantially automatically" is not persuasive. Quantity of patents is not considered to be precedential and particularly if these phrases were well defined in the disclosure. In addition and in line with the Applicant's admission, these searches for merchandise/items results from "minimum manual input from a user", which are based on a business decision criteria, which are most pertinent to the business site owner. Moreover, the Applicant in their current arguments states that these phrases (semi/substantially automatically) can be understood to mean the "process or feature of the invention will occur without or with minimal manual input". In that regard, is use of the language in the claim of "semi/substantially automatically" to be defined - with manual input or without manual input? Thereby, it is not possible to establish the metes and bounds of these claims with the use of these phrases - as defined by the Applicant in their arguments.

Appellant argues that the term criteria is not indefinite and goes on to define the term "selection criteria". The examiner notes that "criteria" as a general term is not necessarily "selection criteria" as defined by appellant's disclosure, therefore as previously stated in the previous office action, the criterion has to be entered by an individual, who has some criteria in mind. For example, an individual would not have any "criteria", especially a businessperson when searching for merchandise. They have business requirements to satisfy and thereby would have criteria in mind such as types of shoes or associated products to search for and download the appropriate product

Art Unit: 3625

information, which satisfy a business criteria that they entered. Thereby, they would have "criteria" associated with a business need and their decision is based on these business requirements such as shoes and which is taught by Catalog and implicitly taught by Bernardo.

Claim Rejections - 35 USC § 103 Rejection

First and in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In that regard, The examiner will further clarify how the combination of Bernardo and Catalog teach all the features of the instant claims thereby also teaching the "website builder".

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a

Art Unit: 3625

reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

To further clarify the combination of Bernardo and Catalog the following discussion is provided with regards to applicant's arguments that "selection criteria module", "merchandise selection module" and "merchandise information download module" are not taught by the combination of Bernardo and Catalog.

"selection criteria module" – as best understood by applicant's specification this module creates the information categories set up in a website or database connected to a website that populates or updates the fields in the database based on XML tags (see FIG 4, item 20, and pages 3,4,7 and 8 of applicant's specification). Bernardo clearly teaches establishing fields within the website for automatic merchandise information population (col 2, lines 50-55). Catalog further teaches the use of XML in a Web-content management system that allows different merchandise criteria such as pricing and availability to be selectively updated based on pre-established criteria (see page 3). Therefore, the combination of Bernardo and Catalog clearly teaches selection criteria module selection module that establishes a selection criteria for merchandise selection.

"merchandise selection module" – as mentioned above Bernardo teaches populating a database based on selection criteria. In addition, Catalog clearly teaches populating a website with information from a plurality of vendors (page 3, para 3), therefore, the combination clearly teaches "a merchandise selection module in the website constructor that selects merchandise offered for sale on the website

Art Unit: 3625

constructed by the website constructor that matches the selection criteria a least substantially automatically, the merchandise selection module being based on merchandise made available by a plurality of vendors”.

“a merchandise information downloading module” as mentioned above Bernardo teaches populating a database based on selection criteria. In addition Catalog clearly teaches populating a website with information from a plurality of vendors (page 3, para 3), therefore, the combination clearly teaches “a merchandise information downloading module that downloads substantially automatically, from a plurality of vendors of merchandise, merchandise information defining the merchandise offered for sale on the website constructed by the website constructor that has been selected by the merchandise selection module”

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Mark Fadok

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